

Application No.: 09/515978

Case No.: 55250US002

Remarks

Claims 9-14, 16-37 and 40 are pending. Claim 15 has been canceled. Claims 9-14, and 24-37 have been withdrawn from consideration. No claims have been amended. No claims have been added.

§ 102 Rejections

Claim 40 stands rejected under 35 USC § 102 as being anticipated by Bacon (US Patent 5,614,286). Based upon the string of papers referred to by the Examiner in the present Office Action (see page 2, paragraph 3), the Examiner's reasoning appears to be that:

Bacon discloses a conformable cube corner reflective sheeting comprising a plurality of discrete cube corner segments (substrate and discontinuous substrate with faces) that are conformably bonded together (col. 6, lines 46-57 and figure 1). The height of the cube corner geometry on the segments is between about 125 to 375 microns (col. 7, lines 1-5). From the figures the retroreflective sheeting can be seen to have a transition line separating the substrates and that the compound face terminates at a nondihedral edge which is not parallel to the nondihedral edge. (See Paper 6, page 4, paragraph 8.)

The Examiner has amplified this rejection in her most recent Office Action. She has argued that the method of forming the product of claim 40 is not germane to the issue of the patentability of the product itself. She has further argued that Applicants have not given a definition to the term "machined substrate" and that therefore she is entitled to give it the meaning of any substrate made by a machine such as a mold.

Claims 16-23 and 40 stand rejected under 35 USC § 102 as being anticipated by Nilsen (US Patent 5,657,162). Based upon the string of papers referred to by the Examiner in the present Office Action (see page 2, paragraph 4 the Examiner's argument appears to be that:

Nilsen discloses a retroreflective article comprising a solid cube corner prism (substrate with faces) coated with a discontinuous metallic layer (discontinuous substrate with faces) (col. 2, lines 35-67 and figure 2). From the figures the retroreflective article can be seen to have a transition line separating the substrates

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and that the compound face terminates at a nondihedral edge which is not parallel to the nondihedral edge. (See Paper 6, page 4, paragraph 9.)

The Examiner has amplified this rejection in her most recent Office Action. She has argued that because she is entitled to give the term "machined substrate" the broadest reasonable interpretation, Nilsen teaches using a machine to make the sheeting because the metal deposits are applied by vapor deposition machine.

The Examiner further argues that the transition line of the present invention is shown in Bacon at figure 1 and in Nilsen at figure 2.

Applicants traverse these rejections. Applicants also reiterate the arguments raised in their previous responses to the Examiner and submit that the following additional points will further illustrate the patentability of the present invention.

The Examiner's argument that a method of forming a product is not germane to the patentability of an article itself appears to be directed to the terminology "machined substrate". Applicants do not agree that this terminology is not germane to the issue of the patentability of the claimed article. To the contrary, they submit that the terminology goes directly to the issue of patentability of the claims over the two references.

The terminology "machined substrate" describes the physical removal of material from the substrate. The physical removal imparts distinctive physical characteristics to the final product. As a result this terminology describes a structural feature of the claimed invention. This terminology must be considered by the Examiner when assessing the patentability of the present invention.

The Examiner's position that Applicants have not defined the meaning of the terminology "machined substrate" is incorrect. This terminology means that material has been physically removed from a substrate to create a desired topography. It is specifically described in many places throughout the application. For example, page 9, line 1 through page 10, line 20 describe the formation of a machined substrate. There are frequent statements that a cutting tool is passed across the surface of a work piece to create a desired machined substrate. See especially page 9, lines 1-5 (cutting tools form a machined surface); and page 9, line 26 through page 10, line 4 (description of various removal techniques to form a machined face). See also page 10, lines 11-20 which describe the surface machined into the machined substrate.

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It is believed to be clear that the Examiner has erred in asserting that Applicants have not defined the meaning a machined substrate. It is equally clear that the Examiner is not entitled to give this terminology the definition "anything made by a machine."

Finally, the Examiner has argued that Bacon and Nilsen each show a transition line. Applicants believe that this too is incorrect. However, in light of the previous comments they do not believe that further comment on this point at this time is necessary.

In view of the above, it is submitted that the application is in condition for allowance. Reconsideration of the application and allowance of all claims is requested.

Respectfully submitted,

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Date

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